

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

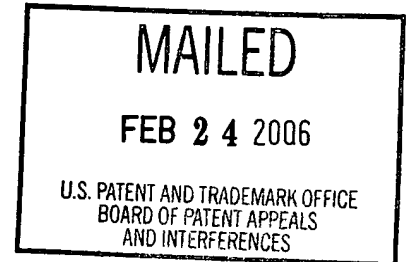
UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte NANDU GOPALAKRISHNAN, ASHOK N. RUDRAPATNA
and GANAPATHY S. SUNDARAM

Appeal No. 2006-0199
Application No. 09/587,727

ON BRIEF



Before JERRY SMITH, BARRY, and NAPPI, Administrative Patent Judges.
JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134
from the examiner's rejection of claims 1-17 and 28-38, which
constitute all the claims pending in this application.

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The disclosed invention pertains to a method for encoding and decoding messages.

1. A method for encoding messages, comprising the steps of:

identifying at least a first plurality of messages indicative of a corresponding first plurality of data transmission rates and second plurality of messages indicative of a corresponding second plurality of data transmission rates based on a prior transmitted message, where the first and second pluralities of messages are unequal; and

transmitting a message from one of at least the first and second pluralities of messages.

28. A method for encoding messages, comprising the steps of:

identifying at least a first group of messages having a first plurality of messages and a second group of messages having a second plurality of messages based on a current system state, where the first and second plurality are unequal; and

transmitting a message from one of at least the first and second group of messages.

The examiner relies on the following references:

Pollmann et al. (Pollmann)	5,233,348	Aug. 03, 1993
Meyer	5,541,595	July 30, 1996
Berger	US 2001/001227	Aug. 09, 2001
		(filed Aug. 04, 1997)
Padovani	6,411,799	June 25, 2002
		(filed Dec. 04, 1997)

Claims 1-17 and 28-38 stand rejected under 35 U.S.C.

§ 103(a). As evidence of obviousness the examiner offers Meyer in view of Pollman and Berger with respect to claims 1-4, 10-13,

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28-31 and 37, and Padovani is added to this combination with respect to claims 5-9, 14-17, 32-36 and 38.

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejections advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejections. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejections and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon and the level of skill in the particular art would have suggested to one of ordinary skill in the art the obviousness of the invention as set forth in claims 28-36. We reach the opposite conclusion with respect to claims 1-17, 37 and 38. Accordingly, we affirm-in-part.

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In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or

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evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually made by appellants have been considered in this decision. Arguments which appellants could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii)(2004)].

We consider first the rejection of claims 1-4, 10-13, 28-31 and 37 based on Meyer, Pollmann and Berger. The examiner's rejection essentially finds that Meyer teaches the claimed invention except that Meyer does not disclose the second group of messages being based on a prior transmitted message. The examiner cites Pollmann as teaching that Huffman coding is based on a statistical analysis of the probability of certain events occurring. Thus, the examiner's position is that Huffman coding is based on previously transmitted data. The examiner also finds that the combination of Meyer and Pollmann does not teach that the encoded data represents a rate request signal. The examiner cites Berger as teaching such a signal. The examiner finds that it would have been obvious to the artisan to include the

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teachings of Berger in the combination of Meyer and Pollmann
[answer, pages 4-5].

With respect to this rejection, appellants argue that the examiner's assertion that it may be desirable in some instances to transmit a data rate request signal is not sufficient suggestion or motivation to establish a prima facie case of obviousness over the cited references. More particularly, appellants argue that Meyer and Pollmann are only concerned with compressing image data and have nothing to do with data transfer rates. They argue that Berger relates to data transfer rates, but has nothing to do with data compression. Appellants assert that the applied prior art provides no motivation for the identifying steps of claims 1, 10 and 37 [brief, pages 5-7].

The examiner responds that the combination of the three references would result in the rate request signals of Berger being Huffman encoded so that the most likely rate request signals will be transmitted using the smallest bit length resulting in less data being sent [answer, pages 9-10].

We will not sustain the examiner's rejection of claims 1-4, 10-13 or 37 because the applied prior art does not support the examiner's rejection of independent claims 1, 10 and 37. Although the examiner has interpreted these independent claims rather broadly, we agree with appellants that there is no

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motivation within the applied prior art for making the modifications proposed by the examiner. We fail to see how the transmission of Huffman encoded data relates to identifying a first plurality of data transmission rates and a second plurality of data transmission rates as claimed in these independent claims, and the examiner's reasoning does not convince us otherwise. We also agree with appellants that there is no suggestion within the applied prior art to send data transmission rates in the systems of Meyer or Pollmann. We conclude that the examiner has combined pieces from disparate prior art references in an improper effort to reconstruct the claimed invention in hindsight.

With respect to claims 28-31, appellants argue that the prior art of record is completely silent with regard to identifying a second group of messages having a second plurality of messages based on a current system state [brief, pages 7-8]. The examiner responds that the first and second messages of Meyer are based on the current state of the system (the probability of the possible events at that time) [answer, page 11].

We will sustain the examiner's rejection of claims 28-31. We note that the original rejection of independent claim 28 was lumped with the rejection of claim 1 and no specific reference to the language of claim 28 was made in the rejection. Appellants'

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argument in the brief simply baldly asserts that the prior art is silent with regard to identifying a second group of messages based on a current system state. In the examiner's response to arguments section of the answer, the examiner points out that the Huffman coding, which represents the probability of the possible events at that time, is a current system state of the system. This position of the examiner seems reasonable. Note also that the rejection of claims 28-31 does not require the teachings of Berger because data transmission rates are not claimed. The reasonable position of the examiner set forth in the response to arguments section of the answer has gone un rebutted by appellants. Since we have no arguments on this record to point out the errors in the examiner's reasonable findings, we sustain the rejection.

We now consider the rejection of claims 5-9, 14-17, 32-36 and 38 based on Meyer, Pollmann, Berger and Padovani. The first three references are applied in the same manner discussed above. The examiner finds that the combination of Meyer, Pollmann and Berger does not teach that the first group is transmitted at a different power than the second group. The examiner cites Padovani as teaching that any group with fewer bits will be transmitted at lower power than a message with more bits. The examiner finds that it would have been obvious to the artisan to

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include the teachings of Padovani in the combination of Meyer, Pollmann and Berger [answer, pages 6-8].

Appellants make the same arguments that we considered above, and appellants assert that Padovani fails to remedy the deficiencies of the other references [brief, pages 8-10]. The examiner, of course, asserts that there are no deficiencies in the other references as discussed above [answer, pages 12-13].

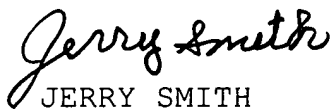
We will not sustain the rejection of claims 5-9, 14-17 and 38 because these claims contain limitations similar to the limitations of claim 1 discussed above. We will sustain the examiner's rejection of claims 32-36 because these claims contain limitations similar to the limitations of claim 28 discussed above.

In summary, we have sustained the examiner's rejection of claims 28-36, but we have not sustained the examiner's rejection of claims 1-17, 37 and 38. Therefore, the decision of the examiner rejecting claims 1-17 and 28-38 is affirmed-in-part.

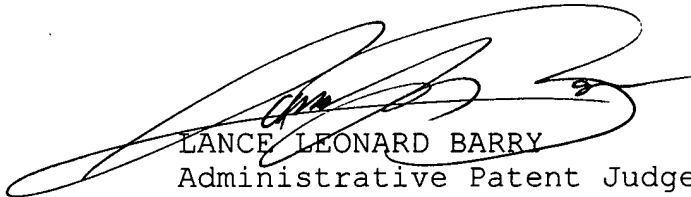
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No time period for taking any subsequent action in
connection with this appeal may be extended under 37 CFR
§ 1.136(a)(1)(iv).

AFFIRMED-IN-PART



JERRY SMITH
Administrative Patent Judge



LANCE LEONARD BARRY
Administrative Patent Judge



ROBERT NAPPI
Administrative Patent Judge

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